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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.         | CONFIRMATION NO.       |
|---|-------------|----------------------|-----------------------------|------------------------|
| 10/580,073  | 05/19/2006  | Bogumil Milkowski    | IVT201                      | 9590                   |
| 7590<br>Horst M Kasper<br>13 Forest Drive<br>Warren, NJ 07059 |             | 06/02/2009           | EXAMINER<br>HICKS, ROBERT J |                        |
|   |             |                      | ART UNIT<br>3781            | PAPER NUMBER           |
|   |             |                      | MAIL DATE<br>06/02/2009     | DELIVERY MODE<br>PAPER |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

**Application No.**

10/580,073

**Applicant(s)**

MILKOWSKI ET AL.

**Examiner**

ROBERT J. HICKS

**Art Unit**

3781

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 10-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 10-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 May 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |  |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>4/30/2007, 6/2/2008</u> | 6) <input type="checkbox"/> Other: ____  |

## DETAILED ACTION

### *Priority*

1. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d).

### *Information Disclosure Statement*

2. The listing of the reference PL-336680 in the specification is not a proper information disclosure statement [Paragraph 2 Line 1]. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609.04(a) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the reference has been cited by the examiner on form PTO-892, it has not been considered.

### *Specification*

3. The disclosure is objected to because of the following informalities:
  - a. The line "The height of the annular thickened rim should vary from 1.1 to 2.0 of the flange thickness" [Paragraph 12 Lines 4-6] could be written as "The height of the annular thickened rim should vary from 1.1 to 2.0 times the flange thickness."
  - b. The line "The height h of the thickened rim 5a (5b, 5c) varies from 1.1 to 2.0 of the flange thickness" [Paragraphs 20, 21, and 22, Lines 5-6, respectively] could be written as "The height of the annular thickened rim 5a (5b, 5c) varies from 1.1 to 2.0 times the flange thickness."

Appropriate correction is required.

***Claim Objections***

**4. Claims 12-16 are objected to because of the following informalities.**

5. Regarding Claims 12 and 14-16, the preambles "The preform according to claim (10)" could have the parentheses removed from the claim number 10.

6. Regarding Claim 13, the claim is objected to because of the following informalities:

a. The claim is objected to because it includes reference character "3" [Claim 13 Line 2] which is not enclosed within parentheses. Reference characters corresponding to elements recited in the detailed description of the drawings and used in conjunction with the recitation of the same element or group of elements in the claims should be enclosed within parentheses so as to avoid confusion with other numbers or characters which may appear in the claims. See MPEP § 608.01(m), and

b. The claim refers back to claim 2; however, claim 2 is cancelled. The preamble could read "The preform according to claim 12".

7. Regarding Claims 14-16, the phrase "...whose height (h) varies from 1.1 to 2.0 of the flange thickness" [Claims 14-16 Lines 2-3, respectively] could be written as "...whose height (h) varies from 1.1 to 2.0 times the flange thickness.". Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

8. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the

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art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

**9. Claims 12-13 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.**

10. Regarding Claim 12, the claim states "...the thickness (g1) of the flange (3) as measured at a distance of approximately 0.5 mm from the flange end (3) ...." There is insufficient disclosure in the specification to support this claim as there is no statement mentioning how to measure or where to measure from the flange end. Claim 13 is rejected as being dependent upon rejected base claim 12.

11. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

**12. Claims 14-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

13. Regarding Claim 14, the claim states "...wherein the rim (5) of the flange (3) has an annular thickening (5a) on top and underneath it"; however, this fails to distinctly point out if the thickening is located on the rim or on the flange itself.

14. Regarding Claim 15, the claim states "...wherein the rim (5) of the flange (3) has a ring-like one sided thickening (5b) on top of it"; however, this fails to distinctly point out if the thickening is located on the rim or on the flange itself.

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15. Regarding Claim 16, the claim states "...wherein the rim (5) of the flange (3) has a ring-like one sided thickening (5c) underneath it"; however, this fails to distinctly point out if the thickening is located on the rim or on the flange itself.

16. Regarding claims 15-16, the phrase "ring-like one sided thickening" renders the claim(s) indefinite because the claim(s) include(s) elements not actually disclosed (those encompassed by " ring-like one sided thickening "), thereby rendering the scope of the claim(s) unascertainable. See *MPEP* § 2173.05(d). It is uncertain if the thickening is shaped like a ring or similar to a ring structure.

***Claim Rejections - 35 USC § 102***

17. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

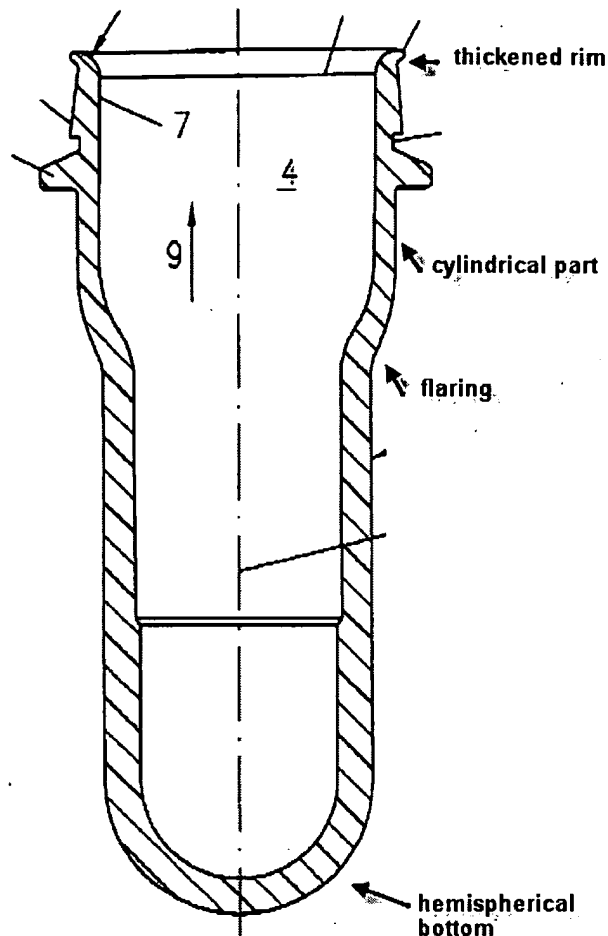
A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**18. Claims 10 and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Bergholtz (6,260,723).**

19. Regarding Claim 10, the patent to Bergholtz – a preform for a container - discloses a preform of a plastic container [1, Fig. 4, Col. 5 Lines 31-33] comprising a conically-shaped container body with a convex hemispherical bottom [Fig. 4], which flares towards a cylindrical neck, whereby by the single-layer body in which the external diameter of the cone as measured at the point of connection with the cylindrical part is equal to the external diameter of the cylindrical part, where the cylindrical part ends with a flange terminated in a thickened rim [11, Fig. 4].

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20. Regarding Claim 11, Bergholtz discloses the preform is designed for packaging foodstuffs [Col. 5 Lines 64-66].

***Claim Rejections - 35 USC § 103***

21. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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22. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

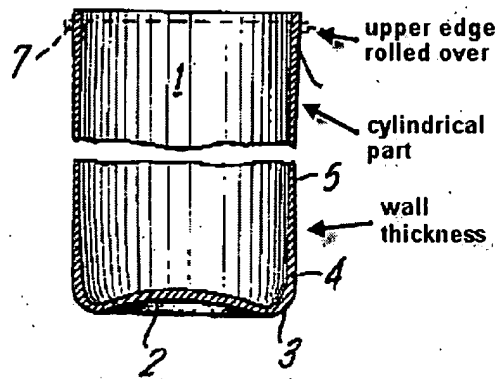
**23. Claims 12 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bergholtz as applied to claim 10 above in view of Yoshikawa (3,785,311).**

24. Regarding Claim 12, Bergholtz discloses all the limitations substantially as claimed, as applied to claim 10 above. Bergholtz does not expressly disclose the features of claim 12; however, the patent to Yoshikawa - a container with a thickened upper rim – discloses a container where in the thickness of the flange [Yoshikawa, 7] measured from the flange end is less than 0.25 mm [Yoshikawa, Col. 4 Lines 18-25], and the wall thickness is less than or equal to the cylindrical wall thickness [Yoshikawa, Col. 3 Lines 60-65]. It would have been obvious at the time of the invention to one of ordinary skill, with market forces or other incentives driving one of ordinary skill to modify the prior art, to manufacture the Bergholtz preform to have a rim with a thickness of less than 0.25 mm and to have the wall thickness less than or equal to the that of the cylindrical wall portion, as suggested by Yoshikawa, for “the other part than the upper edge of said can having an extremely thin thickness so as to curtail the amount of material to be used for the can” [Yoshikawa, Col. 2 Lines 22-25], and since it has been



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held that discovering an optimum value of a result effective variable involves only routine skill in the art. See *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).



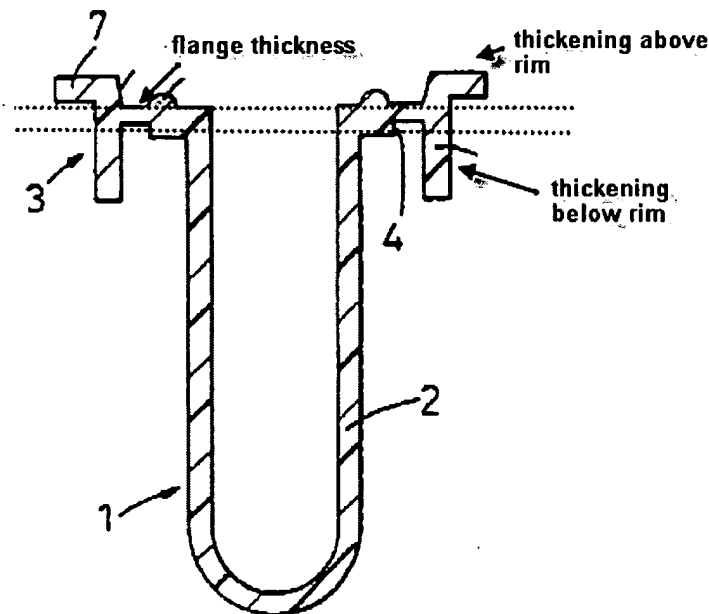
25. Regarding Claim 13, Bergholtz in view of Yoshikawa discloses all the limitations substantially as claimed, as applied to claim 12 above; further, Yoshikawa teaches the thickness of the flange is approximately 0.20 mm [Yoshikawa, Col. 4 Lines 22-25].

26. **Claims 14-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bergholtz as applied to claim 10 above in view of Britton (6,413,467).**

Bergholtz discloses all the limitations substantially as claimed, as applied to claim 10 above. Bergholtz does not expressly disclose the features of claims 14-16; however, the patent to Britton – a preform for container – discloses a preform [Britton, 1] in which the rim [Britton, 3] has an annular thickening on top [Britton, 7], and underneath [Britton, 6] the rim; and in which the height of the thickenings range from 1.1 to 2.0 times the flange thickness [Britton, 4, Fig. 1]. It would have been obvious at the time of the invention to one of ordinary skill, with market forces or other incentives driving one of ordinary skill to modify the prior art, to manufacture the thickening portions on the rim of the Bergholtz preform to be larger than the flange thickness, as suggested by Britton, to be able to locate the container during manufacturing [Britton, Col. 1 Line 66 to Col. 2

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Line 1], and since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. See *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).



### Conclusion

27. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: see PTO-892 Notice of References Cited.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ROBERT J. HICKS whose telephone number is (571)270-1893. The examiner can normally be reached on Monday-Friday, 8:30 AM - 5:00 PM, EST. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Stashick can be reached on (571) 272-4561. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Robert J Hicks/  
Examiner, Art Unit 3781



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